FILE COPY

Office-Supreme Court, U.S.
FILED
NOV 2 1959
JAMES R. BROWNING, Clerk

IN THE

Supreme Court of the United States

OCTOBER TERM, 1959

No. 428

COLUMBIA BOILER CO., INC., *Petitioner*,

v.

MANVILLE BOILER CO., INC., *Respondent*.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Fourth Circuit

REPLY BRIEF OF PETITIONER

RALPH H. HUDSON, Esq.,
700 Tenth Street, N. W.,
Washington 1, D. C.

ZACHARY T. WOBENSMITH, II, Esq.,
1319 Land Title Building,
Philadelphia 10, Pa.

WILL P. MARKS, JR., Esq.,
State Planters Bank Bldg.,
Richmond, Va.

Attorneys for Petitioner

PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.

TABLE OF CONTENTS

	Page
Argument in reply to Respondent's Brief	1-4
Conclusion	5

AUTHORITIES CITED

A. & P. Tea Co. v. Supermarket Corp., 340 U.S. 147, 153, 154	2
Bernard Glagovsky v. Bowcraft Trimming Co., et al., No. 369	2, 3
Stoffel Seals Corporation v. E. G. Brooks Co., No. 361	2, 4
Tatko Brothers Slate Co., Inc. v. Hannon, 122 USPQ 585, 588	4

IN THE

Supreme Court of the United States

OCTOBER TERM, 1959

No. 428

COLUMBIA BOILER CO., INC., *Petitioner*,

v.

MANVILLE BOILER CO., INC., *Respondent*.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Fourth Circuit

---

REPLY BRIEF OF PETITIONER

Respondent's brief correctly states that there is no conflict of decisions between different Courts of Appeals on the facts of record in this case, but mistakenly asserts that the only question that "could" be presented to this Court is the correctness of the decision below upon these facts. As this Court replied to essen-

tially the same argument in *A. & P. Tea Co.* v. *Supermarket Corp.*, 340 U. S. 147, at pages 153 and 154:

> "The questions of general importance considered here are not contingent upon resolving conflicting testimony * * *. The defect that we find in this judgment is that a standard of invention appears to have been used that is less exacting than that required * * *".

The question raised in the present case (and also in *Stoffel Seals Corporation* v. *E. J. Brooks Co.*, No. 361, and *Bernard Glagovsky* v. *Bowcraft Trimming Co. et al.*, No. 369) is a similar question of general importance:

> **was the standard of invention, as established by decisions of this Court, changed by the Patent Act of 1952?**

Obviously this question requires only one answer by this Court, not "scores" of answers "every Term" as implied by Respondent's Brief, page 4.

Respondent states (Respondent's Brief, page 2) that the decision below involves "no new or doubtful question of law" and "no matter of public interest or importance," since it merely determined the issue of patentability based on the particular facts in the record. But a necessary part of that determination was the application of a standard of invention. Respondent freely admits (Respondent's Brief, page 2) that "many Courts of Appeals" have raised the question of "*what is the standard of invention*" under the 1952 Patent Act, and that this question has stimulated much discussion among the patent bar. This doubtful question of law is of "general importance" now for the same reasons that it was in the *A. & P. case*, *supra*.

Conflict between the Circuits as to this question is clearly shown by comparison of the decisions below in the present case and in *Glagovsky* v. *Bowcraft* (No. 369). In the latter case, there had been a long delay in the face of need and plaintiff had solved the problem—

> "by *adopting* a device which, with only a mechanic's changes, had long been *in use in allied arts* * * *."[1] (Emphasis supplied)

In the present case, the Court also found there had been a long delay in the face of need and that plaintiff had solved the problem by the *adoption* and use in a Stauffer boiler of a baffle arrangement long known and *used in tubular boilers*.[2]

Diametrically opposite conclusions were reached in the above parallel situations, because *different standards of invention were applied*. In holding the Glagovsky patent *invalid* (No. 369), the First Circuit expressly declined to reconsider its previous statement that the 1952 Patent Act "merely codified the existing decisional law". In holding the Mandelburg patent *valid* in the present case, the Fourth Circuit obviously applied what it had previously called

> "the standard of invention by the accepted tests, as explained in Lyon v. Bausch & Lomb Optical Co., 2 Cir., 224 F. 2d 530."[3]

---

[1] See appendix to Petition in Glagovsky v. Bowcraft, No. 369, page 22.

[2] See quotation on page 3 of Respondent's Brief and also page 7a of the Petition in the instant case.

[3] See pages 6 and 8 of the Petition in the instant case.

Since the petition in the present case was filed, moreover, the Second Circuit has again disagreed within itself as to what is the proper standard of invention, just as it did in the *Stoffel Seals case* (see Petition for Certiorari No. 361). In *Tatko Brothers Slate Co., Inc.* v. *Hannon*, decided Sept. 11, 1959 and reported at 122 USPQ 585, the majority (Judges Clark and Hincks) reversed the District Court and held the patent in suit invalid for lack of invention. But Judge Madden (United States Court of Claims, sitting by designation) dissented, saying (122 USPQ 588):

> "The case seems to me to be getting itself decided, not on the basis provided by precedent and recent statute, of obviousness to those in the industry, but of obviousness to the judges after the patent has disclosed the device and the industry has adopted it. This seems to me to be a failure by the Court to adjust *itself to the purpose and spirit, the 'mood'*, see Universal Camera Corp. v. Labor Board, 340 U.S. 474, 487, of Section 103 of Title 35, United States Code, enacted in 1952." (Emphasis supplied)

CONCLUSION

The present uncertainty and confusion will continue until this Court defines the "mood" of Section 103 as to the standard of invention to be applied. Petitioner submits that there is ample evidence of doubt and conflict of opinion as to this question, throughout the lower courts, the bar, and the public at large, to warrant its immediate review and answer by this Court.

The Petition should be allowed.

Respectfully submitted.

RALEH H. HUDSON, ESQ.,
700 Tenth Street, N. W.,
Washington 1, D. C.

ZACHARY T. WOBENSMITH, II, ESQ.,
1319 Land Title Building,
Philadelphia 10, Pa.

WIRT P. MARKS, JR., ESQ.,
State Planters Bank Bldg.,
Richmond, Va.

Attorneys for Petitioner